

REMARKS/ARGUMENTS

Claims 1-15, and 17-29 are currently pending in the instant application. Claims 1-4, 7-20, 22, 23, 25, 26, and 29 are amended herein. Applicant acknowledges receipt of the above-identified Office Action, and respectfully traverses the Office Action in its entirety.

RESPONSE TO EXAMINER'S CHARACTERIZATION OF PROVOST

Applicant thanks the Examiner for considering the arguments previously filed, but respectfully disagrees with the Examiner's characterization of both Provost et al., U.S. Patent No. 6,341,265 ("Provost") and Applicant's invention. In the Response to Arguments section beginning on page 16 of the Office Action, the Examiner argues that "clinical record" is broad and could be met by the "claim payment format" of Provost. Applicant respectfully disagrees. As claimed in the instant application, Applicant's invention is directed to the creation of electronic records of a patient clinical encounter. That is, the invention streamlines the process by which electronic records of patient clinical encounters can be created. Such electronic records may be created during a patient clinical encounter (e.g., by an attending physician or an assistant using a laptop, portable digital assistant ("PDA"), smart phone, or other portable computing device), or the electronic records may be created after the patient clinical encounter (e.g., by a physician, nurse, or other person transcribing the information from a paper form). By contrast, Provost's claim forms are used "to determine whether the patient is a beneficiary of an approved insurance plan" and "to determine whether the claim corresponds to health care services that are approved for payment" (Abstract). Provost's claim form is clearly meant to convey only the information necessary to authorize payment of the provider for the services rendered, and not to serve as a record of the patient clinical encounter.

The Examiner also argues that Provost teaches the approval of payment, but that the approval is based on the determination whether or not the diagnosis code and treatment codes are corresponding to the accepted procedures/services. As such, the Examiner argues, Provost teaches a form of authorizing diagnosis for the approving of payment. Applicant respectfully disagrees. Provost merely verifies that the insured, for whom a given claim form is being submitted, has insurance coverage for the services submitted by the provider. By way of example, some physicians dispense allergy shots, but not all insurance companies will pay for their insured to receive such shots. Provost's system uses "the claim form...to determine

whether the patient is a beneficiary of an approved insurance plan”, and to “determine whether the claim corresponds to health care services that are approved for payment”. Provost clearly does not authorize a diagnosis.

REJECTIONS UNDER 35 U.S.C. §112 SECOND PARAGRAPH

The Examiner rejected Claims 1-7, 9-14, and 18-29 under 35 U.S.C. §112, second paragraph. Applicant’s amendments having rendered the Examiner’s rejection moot, Applicant respectfully requests that the Examiner withdraw the rejection.

REJECTIONS UNDER 35 U.S.C. §101

The Examiner rejected Claims 1-8, 12-14, 18, and 23-28 under 35 U.S.C. §101. Applicant’s amendments having rendered the Examiner’s rejection moot, Applicant respectfully requests that the Examiner withdraw the rejection.

REJECTIONS UNDER 35 U.S.C. §102 - ANTICIPATION

The Examiner rejected Claims 8, 15, and 29 under 35 U.S.C. §102(b) as being anticipated by Provost. Applicant asserts that Provost is not proper prior art under 35 U.S.C. §102(b). For a reference to be proper prior art under 35 U.S.C. §102(b), the reference must have been publicly available “...more than one year prior to the date of the application for patent...”. The instant application claims the benefit of Provisional U.S. Patent Application Serial No. 60/247,246, filed November 7, 2000. As such, for a reference to be prior art against the instant application under 35 U.S.C. §102(b), the reference must have been publicly available prior to November 7, 1999. Provost was not publicly available until at least January 22, 2002. Therefore, Provost is not proper prior art under 35 U.S.C. §102(b).

For the purposes of this response, it is assumed that the Examiner intended to reject Claims 8, 15, and 29 under 35 U.S.C. §102(e) as being anticipated by Provost. The Court of Appeals for the Federal Circuit has consistently held that “Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.” Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick, 221 USPQ 481, 485 (Fed. Cir. 1984). Applicant respectfully traverses the Examiner’s rejection as Provost does not contain disclosure of each and every element of Applicant’s claimed invention.

With respect to Claim 8, the Examiner argues that Provost discloses providing a selection interface, adapted to facilitate the user selection of one of a plurality of data values. Applicant respectfully traverses. Provost discloses a form comprising fields 44 “designed to receive and

display diagnosis codes representing the health care provider's diagnosis of the patient or the nature of the patient illness or injury" (Column 9, lines 36-39). Provost does not teach or suggest a selection interface adapted to facilitate the selection of one of a plurality of data values. Thus, Provost clearly does not anticipate Applicant's claimed invention as recited in Claim 8. In addition, Applicant's amendments have rendered the Examiner's remaining arguments moot, and Applicant respectfully requests that the rejection be withdrawn.

With respect to Claim 15, the Examiner argues that Provost discloses the clinical chart format recited in Applicant's claim. Applicant respectfully traverses. A clinical chart is a term of art in the medical community, and is well understood as a record of information relevant to the patient's health, including various aspects such as lab tests ordered and the results thereof, patient symptoms, and the like which are used to arrive at a diagnosis. By contrast, the form disclosed in Provost is designed to obtain payment for the treatments rendered, and therefore only includes information pertinent to billing and the determination of whether the charges are appropriate given the patient's health insurance, such as the ultimate diagnosis, the procedure(s) or service(s) performed, supplies used, etc. Provost clearly does not teach or suggest the clinical chart format recited in Applicant's claim, and Applicant respectfully requests that the Examiner withdraw the rejection of Claim 15 for at least this reason.

Applicant's amendments having rendered the Examiner's remaining arguments moot with respect to Claim 15, Applicant respectfully requests that the rejection be withdrawn.

With respect to Claim 29, the Examiner argues that Provost discloses a system which prompts for clinically relevant inputs used to generate an electronic record of a patient clinical encounter. Applicant respectfully traverses. As described above, Provost discloses a form for requesting payment for services rendered by a medical caregiver. Provost does not teach or suggest Applicant's claimed user interface which prompts for clinically relevant inputs used to generate an electronic record of a patient clinical encounter. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection.

Applicant's amendments having rendered the Examiner's remaining arguments moot with respect to Claim 29, Applicant respectfully requests that the rejection be withdrawn.

Claims 18 and 19 are rejected under 35 U.S.C. §102(e) as being anticipated by Jacobs, U.S. Patent No. 6,049,794 ("Jacobs"). Applicant respectfully traverses the rejection in its entirety. However, in an effort to clarify the nature of Applicant's invention, Applicant has

amended Claims 18 and 19. Applicant's amendments having rendered the Examiner's rejection moot, Applicant respectfully requests that the Examiner withdraw the rejection.

Claims 12-14 and 23-28 are rejected under 35 U.S.C. §102(e) as being anticipated by Roberge et al., U.S. Patent No. 6,381,611 ("Roberge"). Applicant respectfully traverses the rejections in their entirety. However, in an effort to clarify the nature of Applicant's invention, Applicant has amended Claim 12. Applicant's amendments having rendered the Examiner's rejection moot, Applicant respectfully requests that the Examiner withdraw the rejection.

REJECTIONS UNDER 35 U.S.C. §103 - OBVIOUSNESS

The Examiner rejected Claims 9-11 and 17 under 35 U.S.C. §103(a) as being unpatentable over Provost. Applicant respectfully traverses the rejections in their entirety. However, in an effort to better clarify Applicant's invention, Applicant has amended Claims 9-10 and 17. Applicant's amendments having rendered the Examiner's rejection moot, Applicant respectfully requests that the Examiner withdraw the rejection.

The Examiner rejected Claims 20 and 21 under 35 U.S.C. §103(a) as being unpatentable over Jacobs. Applicant respectfully traverses the rejection. Claims 20 and 21 depend from Claim 19, and are patentable for at least the reasons set forth above with respect to Claim 19.

The Examiner rejected Claims 1-6 under 35 U.S.C. §103(a) as being unpatentable over Provost in view of Jacobs. Applicant respectfully traverses the rejection. It is well established that, to show obviousness, all limitations must be taught or suggested by the prior art. In Re Boyka, 180 U.S.P.Q. 580, 490 F.2d 981 (CCPA 1974); MPEP § 2143.03. It is error to ignore specific limitations distinguishing over the references. In Re Boe, 184 U.S.P.Q. 38, 505 F.2d 1297 (CCPA 1974); In Re Saether, 181 U.S.P.Q. 36, 492 F.2d 849 (CCPA 1974); In Re Glass, 176 U.S.P.Q. 489, 472 F.2d 1388 (CCPA 1973). Neither Provost nor Jacobs, nor the combination thereof, teaches or suggests a user interface module comprising a plurality of fields, wherein the plurality of fields are arranged as on a clinical chart, as recited in Applicant's Claim 1. Applicant respectfully asserts that Claim 1 is therefore distinguishable over the prior art, and withdrawal of the rejection thereto is respectfully requested. Claims 2-6 depend from Claim 1, and are patentable for at least the reasons set forth above with respect to Claim 1. Applicant therefore respectfully requests that the Examiner withdraw the rejection.

The Examiner rejected Claim 7 under 35 U.S.C. §103(a) as being unpatentable over Provost in view of Jacobs, and further in view of Roberge. Applicant respectfully traverses the

RESPONSE

Examiner: BUI, Kim T.

Serial No. 09/772,394

Atty. Docket No.: 79731.010100

rejection. Neither Provost nor Jacobs nor Roberge, nor the combination thereof, teaches or suggests a user interface that causes forms and controls to be presented in a format similar to a clinical chart, as recited in Applicant's Claim 7. Applicant respectfully asserts that Claim 7 is therefore distinguishable over the prior art, and withdrawal of the rejection thereto is respectfully requested.

CONCLUSION

Having responded to all objections and rejections set forth in the outstanding Office Action, it is submitted that the currently pending claims are in condition for allowance and Notice to that effect is respectfully solicited. Additional characteristics or arguments may exist that distinguish the claims over the prior art cited by the Examiner, and Applicant respectfully preserves the right to present these in the future, should they be necessary. In the event that the Examiner is of the opinion that a brief telephone or personal interview will facilitate allowance of one or more of the above claims, he is courteously requested to contact applicant's undersigned representative.

Respectfully submitted,

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Filed: July 17, 2006